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PATENT

Attorney Docket No. 09/666,463  
TECH CENTER 1616/2000



22852

PATENT TRADEMARK OFFICE



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Aude LIVOREIL

Application No.: 09/666,463

Filed: September 20, 2000

For: COMPOSITION COMPRISING A  
CYCLOHEXANE-BASED COMPOUND AND  
USE OF SAID COMPOUND TO  
STRUCTURE A COMPOSITION

Group Art Unit: 1616

Examiner: Alton N. Pryor

#5  
AKO  
5-11-02

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

**RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT**

In the written Restriction and Election of Species Requirement, dated March 27, 2002, the Office required restriction under 35 U.S.C. § 121 to one of the following groups of claims:

- |                  |   |
|------------------|---|
| <b>Group I</b>   | Claims 1 to 67, drawn to a compound of formula (I), compositions comprising same, and to a process of applying compounds or compositions comprising same; |
| <b>Group II</b>  | Claims 68-71, drawn to a process of structuring a composition in the form of a solid or a gel, comprising a compound of formula (I);                      |
| <b>Group III</b> | Claim 72, drawn to a method of making a direct dye, comprising a compound of formula (I); and   |
| <b>Group IV</b>  | Claim 73, drawn to a method of manufacturing a make-up product, comprising a compound of formula (I).   |

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The requirement for restriction is respectfully traversed. To be fully responsive, however, Applicant elects, with traverse, **Group I**, comprising Claims 1 to 67, drawn to a compound of formula (I), compositions comprising same, and to a process of applying compounds or compositions comprising same.

The Office contends that the inventions of Groups I, II, III, and IV are unrelated because the inventions allegedly "have different functions". (Office Action, page 2.) The Office's position is that restriction is proper because a search required for one invention is allegedly "not required for all inventions." (*Id.*)

Applicant initially traverses the restriction requirement on the grounds that the Office has not shown that there would be a serious burden to examine the claims of Groups I-IV together. This serious burden is one necessary criterion for a restriction requirement. M.P.E.P. § 803. Applicant respectfully submits that a search of the subject matter of Groups II through IV, in addition to the subject matter of Group I, would not be burdensome because a search of the subject matter of Groups II-IV should encompass the search of the subject matter of Group I since all claims recite a compound encompassed by formula (I). Accordingly, Applicant respectfully requests that all the claims, 1-73, be examined together in this application.

In addition, the Office required Applicant to elect a single disclosed species comprising a compound of formula (I) for examination on the merits and identify the claims readable on the elected species, including any claims subsequently added.

The election of species requirement is respectfully traversed. To be fully responsive, however, Applicant provisionally elect, with traverse, cis-1,3,5-tris(oleylaminocarbonyl)cyclohexane. This is the compound of formula (I) wherein each

R group is hydrogen and each Y group is an oleylaminocarbonyl group. The specification discloses the elected species in Example 1, on page 20, lines 1-9, and in Claim 13, second line. At least claims 1-2, 4-17, and 19-73 read on the elected species.

Applicant traverses the election of species requirement on the grounds that the Office has not shown that there would be a serious burden to examine all of the claimed species. In fact, the Office has failed to show that any burden exists. Accordingly, Applicant respectfully requests that the full scope of the claimed invention be examined in this application without an election requirement. If the Office chooses to maintain the election requirement, however, and should the elected species be found allowable, Applicant expects the Office to continue to examine the full scope of the claimed subject matter to the extent necessary to determine the full scope of the patentability thereof, *i.e.*, extending the search to the non-elected species, such as of claims 3 and 18 which read on non-elected species, as is the duty of the Office according to MPEP § 803.02 and 35 U.S.C. § 121.

In addition, the Office states that upon allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species written in dependent form or otherwise including all the limitations of an allowed generic claim.

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call Applicant's undersigned representative at 202-408-4128.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: April 26, 2002

By: 

Charles D. Niebylski  
Reg. No. 46,116

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